

Application No. 09/989,351

Amendment A

Reply to Office Action of November 3, 2003

Inventor(s) Name: William Plenderleith

Attorney Docket No.: 717901.16

REMARKS

Applicant deeply appreciates that the prior preliminary amendment of 20 November 2001 has been entered. There is an acknowledgement by the Examiner of a claim of domestic priority. Applicant will assume that the Examiner is referring to the claim to priority to International Application No. PCT/GB00/01926 filed May 22, 2000 and Great Britain Patent No. 9911843.2, filed May 22, 1999 that was made in the preliminary amendment dated March 1, 2002 and perfected with the filing of the certified copies of International Application No. PCT/GB00/01926 and Great Britain Patent No. 9911843.2 on April 19, 2003.

Objection to the Claims:

Claim 7 was objected to because it recited "a rotatable disk." This was amended to "one of said two or more rotatable disks" for logical consistency with the other pending claims. No new matter has been added and it is respectfully believed that this objection is overcome.

Rejection Under 35 U.S.C. Section 112:

Claim 9 was rejected under 35 U.S.C. Section 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, "said central portion" was rejected for lacking an antecedent basis. Claim 9 is now amended to depend from Claim 5 rather than Claim 1. Claim 5 already refers to a "central portion." Therefore, no new matter is added and it is respectfully believed that this rejection is overcome. Although not rejected, Claim 10 was also amended to depend from Claim 5 rather than Claim 1 to obviate this same issue.

Rejection Under 35 U.S.C. Section 102:

Claim 1 was rejected under 35 U.S.C. Section 102(b) as being anticipated by Guidry (U.S. Patent No. 5,584,787). Guidry recites: "**A balancing apparatus emulating the acrobatics associated with skate boards etc.** having a rectangular platform, one or more hemispherical, pivotal fulcrums, rotational with respect to a rectangular platform, and a foot plate, attached to the fulcrum member. ... **The user stands on one foot plate and attempts to maintain balance** on the fulcrum member while manipulating the platform with the other foot, at the opposite end of the apparatus, which may also contain a fulcrum member or a stationary, conical member." (Abstract, Lines 1-5 and Lines 10-14). Therefore, Guidry discloses a static balancing device that is only for emulating snowboarding or skateboarding and is not intended to even move across a floor. Guidry does not disclose a device for actually travelling over grassland or similar terrain.

Guidry also recites: "Initial training starts with a balance board 10 fitted with one rotatable, hemispherical pivot 12 and **one stationary, truncated conical member 6** thus allowing the user to learn both balance and rotation while **maintaining some degree of stability**. The stationary member 6 restricts rotation and stabilizes tilting of the hemispherical pivot 12 when the user's body weight is shifted. As the user advances in skill, **the conical, stationary member 6 type board, illustrated in FIGS. 1 & 3, may be replaced by either the more advanced dual pivot type balancing board 20, illustrated in FIGS. 2 & 4 or a board outfitted for dual, hemispherical pivots 12 but having been fitted with a stationary, conical member 6 which can be removed and replaced with a second, rotatable, hemispherical pivot 12.**" (Column 3, Lines 43-55). Therefore, the balancing apparatus of Guidry is a static

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apparatus having a stationary member. It is not designed to operate as sports vehicle. The balancing apparatus of Guidry must be used indoors or on a similar level-supporting surface. It is now a basic tenet of patent law that the results and advantages produced by the claimed subject matter, of which the prior art is devoid, cannot be ignored simply because the claim limitations are similar to the otherwise barren prior art.

In marked contrast, Applicant's Claim 1, as amended, recites: " A vehicle for travelling over grassland and similar terrain, said vehicle comprising a generally horizontal platform having attached to its underside two or more rotatable disks each having a lower surface adapted to contact the ground, **wherein said platform comprises a first area on its upper side towards the front of said platform adapted to receive a first foot of a user, and a second area on its upper side towards the rear of said platform adapted to receive a second foot of the user,** each of said two or more rotatable disks being arranged to rotate **relative to the first and second areas of the platform** about a generally vertical axis, the underside of each of said two or more rotatable disks being substantially convex in form." Support for this amendment can be found in original Claim 5 so that no new matter is added. Guidry recites: " A circular foot plate 16 is then attached perpendicularly to the end of the cylindrical portion 8 of the hemispherical pivot 12 **with screws 15...**". (Column 3, Lines 18-20). Therefore, **these circular footplates 16 recited in Guidry are fixedly attached** to the hemispherical pivots 12 while Applicant's claim 1 requires the first area and the second area being adapted to receive the feet of the user **must be arranged to rotate relative to the first and second areas of the platform.** Moreover, the balancing board 10 disclosed in Guidry does not roll over a supporting surface and function as a sports vehicle.

It is respectfully believed that patentability of the claimed subject matter must be determined in view of the invention "as a whole." Moreover, for a valid 35 U.S.C. Section 102 rejection, it is respectfully believed that a single reference must teach each and every element of the rejected claim. In this case, the "**...platform comprises a first area on its upper side towards the front of said platform adapted to receive a first foot of a user, and a second area on its upper side towards the rear of said platform adapted to receive a second foot of the user, each of said two or more rotatable disks being arranged to rotate relative to the first and second areas of the platform about a generally vertical axis...**" are completely missing elements. While in use, the hemispherical pivots 12 disclosed in Guidry cannot rotate relative to the first and second areas **since the feet of the user will directly rotate the hemispherical pivots.** Moreover, Guidry does not disclose a **first area on its upper side towards the front of said platform adapted to receive a first foot of a user.** In addition, Guidry does not disclose a **second area on its upper side towards the rear of said platform adapted to receive a second foot of the user.** Likewise, Guidry does not disclose **two or more rotatable disks being arranged to rotate relative to the first and second areas of the platform.** It is respectfully believed that all claim limitations and functional language must be considered and cannot be ignored. The Federal Circuit has long held that a key element in the claim, much less numerous key elements in the claim, not found in the directly pertinent prior art, cannot be ignored in the face of the fact that it led to the successful results produced by the device. It is respectfully believed that "...a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F. 2d 628, 631 (Fed. Cir. 1987). Furthermore, "the identical

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invention must be shown in as complete detail as is contained in the... claim." Richardson v. Suzuki Motor Co., 868 F. 2d 1226, 1236 (Fed. Cir. 1989).

Moreover, a proper application of a reference against a device described and claimed in a patent application requires broadly that the anticipatory device be substantially the same as the anticipated device in structure, function and result. In this case, the structure is different since there is no first area on its upper side towards the front of said platform adapted to receive a first foot of a user, there is no second area on its upper side towards the rear of said platform adapted to receive a second foot of the user and there are no two or more rotatable disks being arranged to rotate **relative** to the first and second areas of the platform. Although it is respectfully believed that just one missing structural element will suffice to overcome this rejection, in this case, there are at least three significant structural differences.

Also the function of the device disclosed in Guidry is to improve balancing to create an emulation of skateboards or snowboards and is not a sports vehicle meant for travel over terrain. This is a completely different function.

Finally, the result is very different. With the Applicant's Invention, the feet are strapped to the top of the board and the rotatable disks are free to roll over terrain. As the board is tilted to one side, the rotatable discs rotate and roll along the ground. With Guidry, this result is impossible since the hemispherical pivots are not free to rotate but can only turn a few degrees in conjunction with the position of the feet of the user and not relative thereto. Therefore, you will stay in one position since there are no rolling disks that can build up speed but merely hemispherical protrusions extending from the bottom of the device in Guidry that are bolted to a foot plate 16. It is now a basic tenet of patent law that the United States Patent Office is not

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permitted to ignore the results and advantages of the claimed subject matter, of which the prior art is devoid, simply because the claim limitations are similar to the otherwise barren prior art.

Therefore, Claim 1 overcomes the rejection under 35 U.S.C. Section 102(b) as being unpatentable over Guidry.

Claims 2-7, 9, 17 and 20 were also rejected under 35 U.S.C. Section 102(b) as being anticipated over Guidry. Since Claims 2-7, 9, 17 and 20 depend from, and contain all of the limitations of Claim 1, Claims 2-7, 9, 17 and 20 are felt to distinguish from Guidry in the same manner as Claim 1. In addition, Claim 6 has been amended to recite: "...wherein the first area of the platform is provided with a first rotatably mounted foot support member, and the second area of the platform is provided with a second rotatably mounted foot support member, **said first and second rotatably mounted foot support members being mounted for rotation independently from said two or more rotatable disks.**" This aspect of allowing the rotatable disks to rotate in one direction and allow the rotatable foot members to rotate in a separate direction, e.g., backwards or forwards for about 60 degrees, is another aspect that is completely missing from any cited prior art. Support for this can be found in Paragraph [0043], Lines 1-13 of the Applicant's Published Patent Application (United States Patent Application 20020030331, Published March 14, 2002) that recites: "FIGS. 14 and 15 illustrate an embodiment in which the top of the platform 1 is provided with rotatable foot support members 100 which are connected by a rotatable hinge 102 to a point on the upper surface of the platform 1 corresponding to the center of rotation of the disk 2. The foot support members 100 in the illustrated embodiment are in the form of rigid plates, which may have rollers, bearings or low-friction coatings (not shown) on their underside so that they can rotate freely with respect to the platform 1. The same spindle

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3 used to mount the rotatable disk 2 can also be used to mount the hinge 102. In this way the foot support members 100 can rotate about axes coincident with the axes of the rotatable disks 2." Therefore, no new matter is added.

Rejection Under 35 U.S.C. Section 103:

Claim 21 was rejected under 35 U.S.C. Section 103(a) as being anticipated by Guidry (U.S. Patent No. 5,584,787) in view of Logan (U.S. Patent No. 4,928,982). Since Claim 21 depends from, and contains all of the limitations of Claim 2 and Claim 1, Claim 21 is felt to distinguish from Guidry in the same manner as Claim 2 and Claim 1 above. It is stated by the Examiner that it "...would have been obvious to someone with ordinary skill in this art to arrange the rotatable disks disclosed in Guidry oppositely inclined to one another as taught by Logan." It is respectfully believed that is no motivation to combine Logan with Guidry since Guidry does not disclose rotatable disks that rotate about generally vertical axis but merely a "rectangular platform with one or more hemispherical, pivotal fulcrums...." (Abstract, Lines 1-4). As shown in FIG. 6 in Guidry, the footplate 16 is bolted 15 in two locations to the fulcrum 12. These fulcrums allow the user to pivot the platform to emulate the balancing required for snowboarding but the "fulcrums" are not rotating about a generally vertical axis to create motion for a sports vehicle to travel through grass or other similar terrain.

Since Guidry does not provide for disks that roll on terrain, it would teach an individual away from combining Guidry with Logan, since Logan requires the use of rotating disks or wheels that provide forward movement. The Supreme Court held in U.S. v. Adams, 383 U.S. 39, 148 U.S.P.Q. 479 (1966), that one important indicium of nonobviousness is "teaching away"

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from the claimed invention by the prior art or by experts in the art at (and/or after) the time the invention was made. **It is respectfully believed that teaching away is the antithesis of the art suggesting that the person of ordinary skill go in the claimed direction and provides a per se demonstration of lack of prima facie obviousness.**

It is respectfully believed that it is improper to apply an "obviousness to try" standard or indulge in hindsight evaluation or reconstruction. See Ecolochem, Inc. v. Southern California Edison Co., 56 U.S.P.Q.2d 1065 (Fed. Cir. 2000). In this case, what is obvious is that which can only be deduced by a logical step-by-step reasoning process from the premises furnished by the prior art. There is no logical step-by-step reasoning process that can be developed from the premises furnished by the prior art and a showing of a suggestion, teaching or motivation to combine the prior art references is an essential component of an obviousness holding since the wheels in Logan rotate to provide forward motion but the fulcrums in Guidry are only to provide a static balancing device to emulate a snowboard and are not to provide any forward motion. C. R. Bard, Inc. v. M3 Systems, Inc., 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998).

Therefore, Claim 21 overcomes the rejection under 35 U.S.C. Section 103(a) as being unpatentable over Guidry in view of Logan.

Since Claim 22 depends from, and contain all of the limitations of Claim 21, Claim 22 is felt to distinguish from Guidry in view of Logan in the same manner as Claim 21 above.

Claim 8 was rejected under 35 U.S.C. Section 103(a) as being anticipated by Guidry (U.S. Patent No. 5,584,787) in view of Powell (U.S. Patent No. 1,975, 661). Since Claim 8 depends from, and contain all of the limitations of Claim 1, Claim 8 is felt to distinguish from Guidry in the same manner as Claim 1 above. Moreover, Powell recites: "A wheel adapted to

roll on a surface..." (Claim 1, Column 2, Line 20). In marked contrast, Guidry discloses: "**A circular foot plate 16 is then attached perpendicularly to the end of the cylindrical portion 8 of the hemispherical pivot 12 with screws 15** thus allowing the platform 2 to be rotatable about the central axis of the hemispherical pivot 12." (Column 3, Lines 18-22). **Therefore, the pivots 12 only rotate to the extent that the user's foot turns. The pivots 12 do not roll on a surface.** Therefore, the static-balancing device disclosed in Guidry would be destroyed with the roller skate wheels found in Powell. Therefore, one of ordinary skill in the art would not have any motivation to make this modification and, in fact, would be specifically motivated not to make this modification. The Federal Circuit has consistently held that when a patentability rejection is based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference, such a proposed modification is not proper and a *prima facie* case of obviousness cannot be properly made. In re Gordon, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

Therefore, Claim 8 overcomes the rejection under 35 U.S.C. Section 103(a) as being unpatentable over Guidry in view of Powell.

Claims 12 and 18 were rejected under 35 U.S.C. Section 103(a) as being anticipated by Guidry (U.S. Patent No. 5,584,787) in view of Heatwole (U.S. Patent No. 4,530,498). Since Claims 12 and 18 depends from, and contain all of the limitations of Claim 1, Claims 12 and 18 are felt to distinguish from Guidry in the same manner as Claim 1 above. Heatwole discloses: "Within recess 70 there is received the head of a bolt 72. **Bolt 72 is threaded to an internal bore in the stem 60 and bearing 58. The bottom surface of element 64 is recessed to receive a rubber pad 74. Pad 74 is an anti-skid and anti-slip layer so as to minimize movement**

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between element 64 and a supporting surface such as a floor. Pad 74 occupies substantially the entire bottom surface of element 64." (Column 2, Lines 56-63). Claim 12 recites: "... wherein each of said two or more rotatable disks is supported on a spindle attached to the underside of said platform." In Heatwole, the bolt 72 or spindle is fixedly attached to the pad 74. The pad 74 is designed so that movement is minimized. This is the opposite of a spindle for a rotating disk where the rotating disk contacts and rolls over the ground to create forward motion for a sports vehicle.

Applicant's Claim 18 recites: "...wherein each of said two or more rotatable disks is hollow, said upper surface of each of said two or more rotatable disks being substantially concave in form." As previously stated, the disks in Heatwole are actually the pads 74. Although there is a concave and hollow aspect to the pads 74, the use of pads that prevent movement against a surface will absolutely and utterly destroy the purpose and function of Applicant's disks, which are to rotate over terrain and create forward motion for a sports vehicle.

If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *Manual of Patent Examining Procedure (M.P.E.P.)* Section 2143.01 and In re Gordon, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). Moreover, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (C.C.P.A. 1959). In this case, the use of disks that roll on the ground would be totally changed by pads that are suppose to prevent movement in relationship to the ground.

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Therefore, Claims 12 and 18 overcome the rejection under 35 U.S.C. Section 103(a) as being unpatentable over Guidry in view of Heatwole.

Since Claims 13-16 and 19 depend from, and contain all of the limitations of Claims 12 and 18, Claims 13-16 and 19 are felt to distinguish from Guidry in view of Heatwole in the same manner as Claims 12 and 18 above.

Claim 10 was rejected under 35 U.S.C. Section 103(a) as being anticipated by Guidry (U.S. Patent No. 5,584,787) in view of Douglass (U.S. Patent No. 5,409,265). Since Claim 10 depends from, and contain all of the limitations of Claim 1, Claim 10 is felt to distinguish from Guidry in the same manner as Claim 1 above. Douglass recites: "The skateboard of the invention, generally designated 10 in FIGS. 1 and 2, comprises a long rectangular body 12, with rounded comers, which is cast in plastic or other sturdy flexible material. **The front 12a and back 12b of body 12 are angled upward allowing greater control and better footing.**" (Column 2, Lines 29-34). This presents a marked contrast to Applicant's Claim 10 that requires: "...the platform has a generally concave shape in a longitudinal direction..." In this case, the **two turned-up ends** for the platform disclosed in Douglass is not a **generally concave shape for the entire platform**. The Merriam-Webster Online Dictionary defines "concave" as: "hollowed or rounded inward like the inside of a bowl." Therefore, the two turned-up ends 12a and 12b do not create a platform that is curved like a bowl. It is respectfully believed that a feature that is not disclosed in either cited Reference cannot come into being by their combination. In addition, it is improper to apply an "obviousness to try" standard or indulge in hindsight evaluation or reconstruction to attempt to arrive at the Applicant's claimed invention. See Ecolochem, Inc. v. Southern California Edison Co., 56 U.S.P.Q.2d 1065 (Fed. Cir. 2000).

Therefore, Claim 10 overcomes the rejection under 35 U.S.C. Section 103(a) as being unpatentable over Guidry in view of Douglass.

Claim 11 was rejected under 35 U.S.C. Section 103(a) as being anticipated by Guidry (U.S. Patent No. 5,584,787) in view of Hamsch (U.S. Patent No. 5,855,385). Since Claim 11 depends from, and contain all of the limitations of Claim 1, Claim 11 is felt to distinguish from Guidry in the same manner as Claim 1 above. Hamsch recites: "In another preferred embodiment illustrated in FIG. 3, platform 12 provides **convex load bearing area 32** on upper surface 34. Convex area 32 is desirably provided across the width of platform 12 extending perpendicularly from central longitudinal axis 14. Generally, materials and construction of platform 12 are selected so as to permit selective deformation of convex area 32 (depending upon operator weight and skill level) so as to vary the arc provided by concave portions 20 and 24 and thereby, sidecut (d)." (Column 4, Lines 19-25). This is only a small area that is convex and does not meet Applicant's claim limitation that requires: "...the **platform has a generally convex shape....**".

It is now a basic tenet of patent law that the results and advantages produced by the claimed subject matter, of which the prior art is devoid, cannot be ignored simply because the claim limitations are similar to the otherwise barren prior art. It is respectfully believed that patentability of the claimed subject matter must be determined in view of the invention "as a whole". In this case, a convex, load bearing, **portion** of a platform is not the same thing as a generally convex platform.

There must be a reason to modify the reference and this reason to modify the reference must be based on objective evidence of record. A showing of a suggestion, teaching or

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motivation to modify, as well as combine, the prior art references is an essential component of an obviousness holding. C. R. Bard, Inc. v. M3 Systems, Inc., 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998). In this case, any suggestion, teaching or motivation to modify the prior art references is wholly absent.

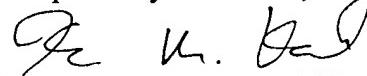
Therefore, Claim 11 overcomes the rejection under 35 U.S.C. Section 103(a) as being unpatentable over Guidry in view of Hamsch.

It is now believed that all of the pending claims in the present application, namely, Claims 1-22 are in condition for allowance. Favorable action and allowance of the Claims is therefore respectfully requested.

If any issue regarding the allowability of any of the pending claims in the present application could be readily resolved, or if other action could be taken to further advance this application such as an Examiner's amendment, or if the Examiner should have any questions regarding this present amendment, it is respectfully requested that Examiner please telephone the Applicant's undersigned attorney in this regard.

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Respectfully submitted,



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